

ESTTA Tracking number: **ESTTA174657**

Filing date: **11/14/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Nissan Jidosha Kabushiki Kaisha a/t/a Nissan Motor Co., Ltd.		
Entity	Corporation	Citizenship	Japan
Address	2 Takaracho, Kanagawa-ku Yokohama-shi, JAPAN		

Attorney information	Gary D. Krugman Sughrue Mion, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3212 UNITED STATES gkrugman@sughrue.com, mperry@sughrue.com, tm@sughrue.com Phone:2026637484
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Registration Subject to Cancellation

Registration No	2758510	Registration date	09/02/2003
Registrant	MOTOREX, INC. 15612 New Century Drive Gardena, CA 90248 UNITED STATES		

Goods/Services Subject to Cancellation

Class 012. First Use: 1999/04/30 First Use In Commerce: 2000/03/07 All goods and services in the class are cancelled, namely: High performance imported automobiles modified to meet US federal motor vehicle standards, and structural parts therefor

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77190857	Application Date	05/25/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	GT R		
Design Mark			

Description of Mark	The mark consists of the letters G, T and R.
Goods/Services	Class 012. First use: Motor vehicles, namely automobiles and structural parts therefor

Attachments	77190857#TMSN.jpeg (1 page)(bytes) 201219 Petition for Cancellation - GTR.pdf (10 pages)(227316 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Gary D. Krugman/
Name	Gary D. Krugman
Date	11/14/2007

4. Respondent, since at least as early as 2000, has imported into the United States Petitioner's limited edition, high performance automobiles under the GTR and SKYLINE GTR marks. On information and belief, Respondent modifies Petitioner's GTR and SKYLINE GTR vehicles in order to make them compliant with U.S. required safety standards following which Respondent re-sells Petitioner's automobiles under the GTR and SKYLINE GTR marks. These automobiles re-sold in the United States are clearly marketed and sold as NISSAN branded products.

5. While Respondent is not an authorized distributor of Petitioner, Respondent's re-sale and distribution of NISSAN automobiles in the United States since 2000 under the GTR and SKYLINE GTR marks has resulted in Petitioner acquiring common law trademark rights in the United States for these trademarks.

6. In addition to Petitioner acquiring common law rights in the United States as a result of the re-sale and distribution of Petitioner's GTR automobiles in the United States by Respondent, Petitioner has also acquired common law rights in the United States in the GTR trademark as a result of the fact that it has become well known and famous in the United States among automobile enthusiasts and others. This fame is as a result of the sale and popularity of Petitioner's GTR automobiles sold in Japan for many years as well as from many high profile media press stories in the United States about these GTR automobiles and the well known automobile races throughout the world where Petitioner's GTR automobiles have competed and won. The fame of Petitioner's GTR automobiles in the United States is also as a result of the

fact that Petitioner's GTR mark has been used under license from Petitioner to depict its GTR automobiles in various video games which are sold globally, including the United States.

7. As a result of the activities leading to Petitioner's GTR mark becoming well known and famous in the United States, the GTR mark, in the United States, has become exclusively associated with high performance automobiles produced by and originating with Petitioner and only Petitioner.

8. Notwithstanding Petitioner's rights in the GTR trademark in the United States, Respondent, without the permission, authorization or knowledge of Petitioner, filed an application to register GTR (stylized) as a trademark for automobiles and structural parts therefor. This application was filed on August 28, 2002, based on Respondents' asserted use of the mark in commerce since March 7, 2000 and received Serial No. 76/444,379. On information and belief, the specimen of use submitted by Respondent in support of its application consisted of a copy of a photograph of the rear of one of Petitioner's vehicles, and the specimen photograph clearly showed Petitioner's NISSAN trademark as well as Petitioner's marks SKYLINE and GTR.

9. Respondent's application for registration of GTR (stylized) included a verified statement that Respondent was the owner of the mark sought to be registered and that no other person, firm, corporation or association had the right to use the mark in commerce.

10. Respondent's application for GTR (stylized) was subsequently approved and issued into Reg. No. 2,758,510 on September 2, 2003.

I. FRAUD.

11. At the time the Respondent filed its application to register the GTR (stylized) mark, Respondent knew it was not the owner of the mark and Respondent knew that the mark identified automobiles produced by and originating with Petitioner. Therefore, Respondent's statements made in the sworn declaration submitted as part of Respondent's application that Respondent was the owner of the mark and that no one else had the right to use the mark were false, material statements made with knowledge of their falsity.

12. As a result of the knowingly false material statements made to the PTO in connection with Respondent's application for registration, the PTO granted Respondent Reg. No. 2,758,510.

13. Respondent's Reg. No. 2,758,510, therefore, was obtained through fraudulent statements made to the PTO in order to obtain a registration to which Respondent was not entitled.

II. LIKELIHOOD OF CONFUSION.

14. As a separate and independent ground for cancellation of Reg. No. 2,758,510, the importation and re-sale by Respondent of Petitioner's GTR automobiles in the United States have resulted in Petitioner obtaining common law rights in the GTR mark which rights are superior to any rights, if any, that Respondent may have in the GTR mark.

15. In addition to Petitioner's common law rights in the United States in the GTR mark as a result of Respondent's importation and re-sale of Petitioner's GTR vehicles in the

United States, Petitioner's GTR mark has become famous and well known to automobile enthusiasts and others in the United States such that Petitioner, as a result of such fame and notoriety, has acquired trademark rights in the United States for the GTR mark, which rights are superior to any rights in the mark, if any, that Respondent may have in the same mark.

16. The registered mark GTR (stylized) so resembles Petitioner's identical mark for identical goods as to be likely to cause confusion, mistake or deception.

III. ABANDONMENT.

17. As a separate and independent ground for cancellation of Reg. No. 2,758,510, Petitioner asserts that, on information and belief, Respondent is no longer an active business entity. Petitioner asserts that it has been unable to contact Respondent and, further, asserts that a check of the California state corporate records show that Respondent corporation is in suspended status. Petitioner further asserts that, while Respondent has an active website, www.motorex.net, a review of the web site shows that Respondent indicates, on the web site, that Respondent no longer imports Petitioner's SKYLINE GTR vehicles.

18. In view of the foregoing, Respondent has abandoned the GTR mark, which abandonment mandates cancellation of Reg. No. 2,758,510.

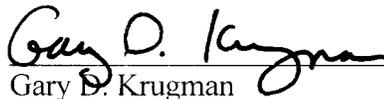
Petition for Cancellation
Mark: GTR (Stylized)

WHEREFORE, it is respectfully requested that this Petition for Cancellation be granted and Reg. No. 2,758,510 be cancelled.

Please charge the \$300 cancellation fee to the undersigned's Deposit Account No. 19-4880. Please charge any deficiency or credit any overpayment to Deposit Account No. 19-4880.

Respectfully submitted,

NISSAN JIDOSHA KABUSHIKI KAISHA
a/t/a/ NISSAN MOTOR CO., LTD.



Gary D. Krugman
Leigh Ann Lindquist
Attorneys for Petitioner
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3202
Phone: (202) 663-7927
Fax: (202) 331-4308
Attorney for Petitioner

Date: November 14, 2007

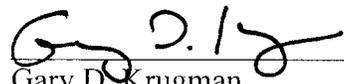
Petition for Cancellation
Mark: GTR (Stylized)

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **PETITION FOR CANCELLATION** has been served on Registrant and counsel for Registrant this 14th day of November, 2007 via first class mail, postage prepaid to:

Motorex, Inc.
15612 New Century Drive
Gardena, CA 90248

Edward O. Ansell, Esq.
Law Office of Edward O. Ansell
427 N. Yale Avenue, #204
Claremont, CA 91711



Gary D. Krugman

Thank you for your request. Here are the latest results from the TARR web server.

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Serial Number: 76444879 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2758510

Mark



(words only): GTR

Standard Character claim: No

Current Status: Registered.

Date of Status: 2003-09-02

Filing Date: 2002-08-28

Transformed into a National Application: No

Registration Date: 2003-09-02

Register: Principal

Law Office Assigned: LAW OFFICE 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2007-07-03

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. MOTOREX, INC.

Address:
MOTOREX, INC.
15612 New Century Drive

Gardena, CA 90248

United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

Phone Number: (310) 523-2233

Fax Number: (310) 523-2235

GOODS AND/OR SERVICES

International Class: 012

Class Status: Active

High performance imported automobiles modified to meet US federal motor vehicle standards, and structural parts therefor

Basis: 1(a)

First Use Date: 1999-04-30

First Use in Commerce Date: 2000-03-07

ADDITIONAL INFORMATION

Description of Mark: The mark consists of stylized letters "G" and "T" positioned above stylized letter "R".

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2007-07-03 - Case File In TICRS

2003-09-02 - Registered - Principal Register

2003-08-04 - TEAS Change Of Correspondence Received

2003-06-10 - Published for opposition

2003-05-21 - Notice of publication

2003-04-24 - Approved for Pub - Principal Register (Initial exam)

2003-04-17 - Examiners amendment e-mailed

2003-04-17 - Previous allowance count withdrawn

2003-04-17 - Approved for Pub - Principal Register (Initial exam)

2003-04-03 - Previous allowance count withdrawn

2003-02-10 - Approved for Pub - Principal Register (Initial exam)

2003-02-10 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Edward O. Ansell

Correspondent

Edward O. Ansell

Law Office of Edward O. Ansell

427 N. Yale Ave.#204

Claremont CA 91711

Phone Number: (909)621-1985

Fax Number: (909)624-1664
